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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/542,374	07/14/2005	Hiroki Akatsuka	Q87773	7777

23373 7590 09/05/2007  
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WASHINGTON, DC 20037

EXAMINER
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TRUONG, THANH K

ART UNIT	PAPER NUMBER
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3721

MAIL DATE	DELIVERY MODE
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09/05/2007

PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

**Office Action Summary**

Application No.

10/542,374

Applicant(s)

AKATSUKA ET AL.

Examiner

Thanh K. Truong

Art Unit

3721

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 09 August 2007.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-9 is/are pending in the application.
- 4a) Of the above claim(s) 5 and 6 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-4 and 7-9 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)                                | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                       | 5) <input type="checkbox"/> Notice of Informal Patent Application                       |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

## DETAILED ACTION

### ***Continued Examination Under 37 CFR 1.114***

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on August 9, 2007 has been entered.

2. Examiner's note: it should be pointed out that the claims (1-4 and 7-9) as recited contain mostly intended use recitations, and in an apparatus claim, the intended use recitation does not provide any structure limitation, and thus it does not carry any patentable weight. For example, claim 1 recited the following:

*"a single pad; and  
a hole for deaeration which is formed so as to penetrate between a first  
surface of the single pad, [which is brought into contact with an inner  
surface of a packaging carton when said shock absorbing material is  
placed in said packaging carton], and a second surface of the single pad  
[on which a product to be packed is placed via a thin film member]."*  
(emphasis added).

it is construed that the phrases, which are underlined and located inside the [ ], only recited the intended use of the apparatus, i.e. the single pad that has a through hole. The intended use recitation describes what the "single pad that has a through hole" does, and it does not provide any structure limitation of the claimed invention.

In other words, a recitation of the intended use of the claimed invention must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim.

***Claim Rejections - 35 USC § 102***

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

4. Claims 1-4 and 7-9 are rejected under 35 U.S.C. 102(b) as being anticipated by Kasakura (US 2001/0030141).

Kasakura discloses a shock absorbing material for packaging comprising, among other things:

a single pad (24, 41); and

a hole (26, 48, 49) which is formed so as to penetrate between a first surface of the single pad, and a second surface of the single pad (figure 8 & 11).

Kasakura further discloses:

Regarding claim 2, the recitation “a deaerating-duct insertion opening” is construed as an opening or a hole that is capable of accommodating a duct. Figures 8 and 11 show holes or openings (26, 48, 49). These holes or openings are clearly

Art Unit: 3721

capable of accommodating the insertion of a duct providing that the duct has the same size as the opening.

Regarding claim 3, grooves which are formed in at least one of the first and second surfaces – figure 11 shows member (42) has grooves on both side of the side walls, these grooves are clearly capable of providing communication between the openings.

Regarding claims 4 and 7, the holes are formed on a side of a dented portion (44) provided in the second surface, the dented portion for placement of the product (figure 11).

Regarding claims 8 and 9, holes (26, 48, 49) are fully enclosed by the shock absorbing material around the perimeter of the holes.

5. Claims 1-4 and 7 are rejected under 35 U.S.C. 102(b) as being anticipated by Koike (US 2002/0189970).

Koike discloses an apparatus comprising: a shock absorbing material (10, 20, 30) for packaging, the material comprising a hole for deaeration (figures 1 and 2 show holes are formed on all sides of the shock absorbing material) which is formed so as to penetrate between a first surface (such as the bottom surface or the outside surfaces of the shock absorbing material) thereof which is brought into contact with an inner surface of a packaging carton (2) when the shock absorbing material is placed in the packaging carton (figure 1), and a second surface (such as the top surface or the inside surfaces

Art Unit: 3721

of the shock absorbing material) thereof on which a target to be packed (50) is placed via a thin film member (6) for packaging which is thinly formed.

Koike further discloses:

Regarding claim 2, the shock absorbing material has a deaerating-duct insertion opening which is formed so as to penetrate between the first and second surfaces, and into which a deaering duct can be inserted (it is construed that the shock absorbing material has grooves and recesses that openings are formed so as to penetrate between the first and second surfaces, and a deaering duct is certainly capable of being inserted into these openings all around the shock absorbing material. Furthermore, the functional recitations of claim 2 only require that the apparatus is capable of performing the functioning as recited).

Regarding claim 3, the material includes grooves for deaeration which are formed in either or both of the first and second surfaces, and which provide communication between the deaerating-duct insertion opening and the hole for deaeration (see paragraph regarding claim 2 above).

Regarding claim 4, the hole for deaeration is formed on a side of a dented portion for product placement formed in the second surface (as mentioned above, holes are formed all around the shock absorbing material for deaeration, and figures 4, 6 and 8 show that the product (50) is placed in the dented portion in the second surface).

Regarding claim 7, at least one dented portion in the second surface, the dented portion for placement of the product therein, wherein at least two holes for deaeration are formed in the dented portion (see paragraph regarding claim 2 above).

***Response to Arguments***

6. Applicant's arguments filed February 26, 2007 have been fully considered but they are not persuasive.

7. In response to the Applicant's argument that: "The alleged hole formed between the hollow projections 15 and 25, however, does not penetrate a single pad, as recited in claim 1, but is merely "formed" when two pads enclose the article 50", this is not found persuasive for the following reason:

The American Heritage Dictionary, defines a "hole" as follow:

1. A hollowed place in something solid; a cavity or pit.
2. An opening or perforation.
3. A space in an otherwise solid mass
4. An opening, especially in a solid structure
5. An open space allowing passage

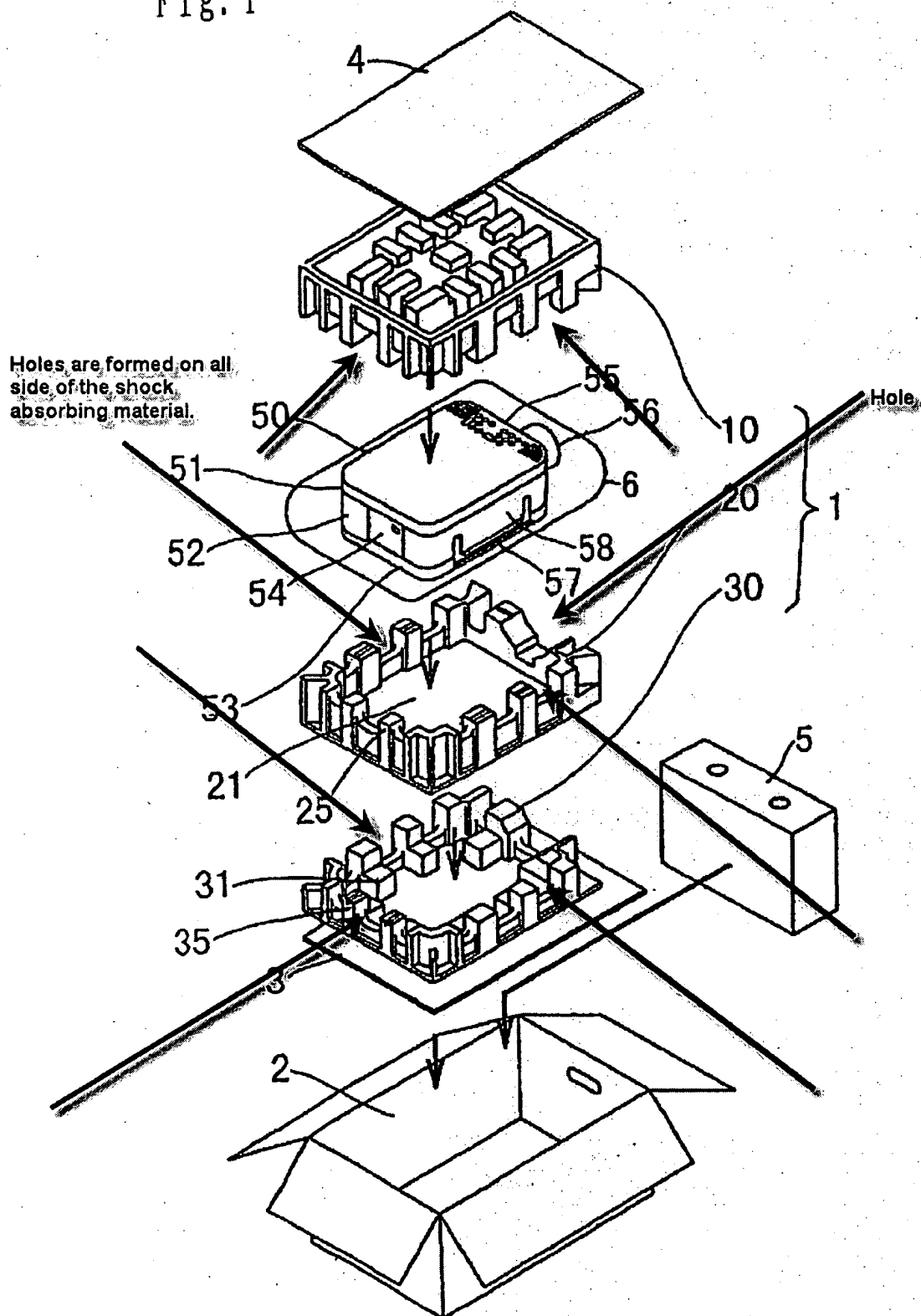
(The American Heritage® Dictionary of the English Language, Fourth Edition Copyright © 2004, 2000 by Houghton Mifflin Company.)

Accordingly, the examiner maintains that figures 1-8 of Koike clearly show that holes are formed on all sides of the shock absorbing material. For example, figure 1 shows opening spaces between projections, on all sides, of each of shock absorbing materials (10, 20, 30).

Attached is the copy of Fig. 1 of Koike reference, and the arrows provided pointing to the openings (or holes) on all side of the shock absorbing materials (10, 20, 30), and each shock absorbing material is a single pad.

Art Unit: 3721

Fig. 1



Art Unit: 3721

**Conclusion**

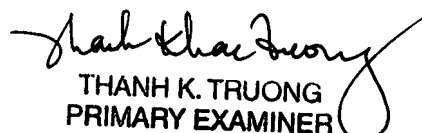
8. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

9. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Thanh K. Truong whose telephone number is 571-272-4472. The examiner can normally be reached on Mon-Thru 8:00AM - 6:30PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Rinaldi Rada can be reached on 571-272-4467. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

tkf  
August 31, 2007.

  
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PRIMARY EXAMINER  
TECHNOLOGY CENTER 3700